Serial No. 10/510,057   PATENT
Appeal Brief dated April 13, 2009   PU020097
Reply to Final Office Action of November 13, 2008   Customer No. 24498

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants	:	Scott Allan Kendall, et al.
Serial No.	:	10/510,057
Filed	:	October 4, 2004
Title	:	**BROWSER WITH SETTING SAVING FEATURE**
Examiner	:	Edward J. Kim
Art Unit	:	2455

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

      In response to the Final Office Action dated November 13, 2008, and further to the Notice of Appeal filed on February 11, 2009, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing LLC.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellant, the Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-21 are pending in this application, and are rejected. The rejection of claims 1-21 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of November 13, 2008 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 defines a method of communicating electronic information using a browser (page 3, lines 9-10). The method comprises the steps of: a. invoking the browser in a display device (page 3, lines 10-11); b. accessing a web page in response to a viewer specifying a URL in the browser (page 3, line 11; page 7, lines 22-27); c.   retrieving   a   viewer adjustable setting for the URL from a memory (page 7, lines 28-29); d. applying the retrieved viewer adjustable setting to the web page (page 7, lines 29-32); e. automatically saving a current state of the viewer adjustable setting in the memory in response to a signal for exiting the web page (page 8, lines 6-8); and f. automatically applying the current state of the viewer adjustable setting to the web page a next time the web page is accessed (page 3, lines 14-15).

Independent claim 5 defines a method of displaying a web page with a user-preferred format setting for the web page (page 3, lines 16-17). The method comprises the steps of: a. receiving a user input representing the

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user-preferred format setting for the web page while the web page is displayed (page 3, lines 17-18; page 8, lines 2-4); b. automatically storing the user-preferred format setting in association with a URL for the web page in response to a signal for exiting the web page (page 3, lines 18-19; page 8, lines 6-8); and c. automatically applying the user-preferred format setting to the web page a next time the web page is accessed (page 3, lines 19-21).

Independent claim 11 defines a system (element 10) for processing requests for web pages comprising: a. means (element 21) for fetching a web page upon receipt of a URL request (page 7, lines 22-27); b. means (element 24) for receiving a user adjustable format preference for the web page (page 8, lines 2-4); c. means (element(s) 22/23) for automatically storing a current user adjustable format preference for the web page in response to a signal for exiting the web page (page 8, lines 6-8); and d. means (element 21) for automatically applying the current user adjustable format preference to the web page a next time the web page is fetched (page 3, lines 19-21).

Independent claim 16 defines a computer program embodied on a computer readable medium for displaying a web page with user-preferred formatting for that web page (page 3, lines 16-17; page 7, lines 22-24). The computer program comprises: a. a code segment for receiving user adjustable format selections for a displayed web page (page 8, lines 2-4), and for automatically storing a current user adjustable format selection in association with a URL for the displayed web page in response to a signal for exiting the displayed web page (page 8, lines 6-8); b. a code segment for receiving a next request for the URL, and for automatically retrieving the current user adjustable format selection in response to the next request (page 3, lines 19-20); and c. a code segment for automatically displaying the web page with the current user adjustable format selection in response to the next request (page 3, lines 20-21).

VI. Ground of Rejection to be Reviewed on Appeal

The rejection of claims 1-21 under 35 U.S.C. §103(a) over U.S. Patent No. 7,149,982 issued to Duperrouzel et al. (hereinafter, "Duperrouzel") is presented for review in this appeal.

VII. Argument

The rejection of claims 1-21 under 35 U.S.C. §103(a) over Duperrouzel should be reversed for at least the following reasons.

Appellants first note that one of the notable features of the claimed invention is that user settings for a web page are saved <u>in response to a signal for exiting the web page</u>. This feature of the claimed invention is recited in each of the independent claims under appeal as follows:

> "e.   automatically saving a current state of the viewer adjustable setting in the memory <u>in response to a signal for exiting the web page</u>" (emphasis added; see claim 1),

> "b.   automatically storing the user-preferred format setting in association with a URL for the web page <u>in response to a signal for exiting the web page</u>" (emphasis added; see claim 5),

> "c.   means for automatically storing a current user adjustable format preference for the web page <u>in response to a signal for exiting the web page</u>" (emphasis added; see claim 11), and

> "a.   a code segment for receiving user adjustable format selections for a displayed web page, and for automatically storing a current user adjustable format selection in association with a URL for the displayed web page <u>in response to a signal for exiting the displayed web page</u>" (emphasis added; see claim 16)

On pages 3, 5, 7 and 9 of the final Office Action dated November 13, 2008, the Examiner admits that Duperrouzel fails to disclose the aforementioned feature of independent claims 1, 5, 11 and 16, <u>but simply alleges that such a feature is obvious without properly citing any prior art</u>

<u>reference to support this allegation</u>. Accordingly, Appellants submit that the instant rejection under appeal is deficient in that the Examiner has not properly established a *prima facie* case of obviousness under 35 U.S.C. §103(a) by citing prior art which discloses or suggests each and every feature of the claimed invention.

In an effort to support the instant rejection under appeal, the Examiner alleges:

> "… Dupperouzel discloses instances where the user manually saving [*sic*, saves] the settings for a web page before leaving a web site. It would have been obvious to one of ordinary skill in the art … to modify Dupperouzel to automatically save the settings of the web site when leaving the web site." (see page 3 of the final Office Action dated November 13, 2008)

In response, Appellants submit that the Examiner's proposed modification to Dupperouzel is the clear result of impermissible hindsight reconstruction. In particular, Appellants note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a proper basis for an obviousness rejection under 35 U.S.C. §103(a) <u>unless the prior art suggests the desirability of such a modification</u>. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, the cited prior art, Dupperouzel, clearly fails to teach or suggest the <u>desirability</u> of saving user settings for a web page <u>in response to a signal for exiting the web page</u>, as required by independent claims 1, 5, 11 and 16. Rather, Dupperouzel expressly teaches that user settings for a web page are saved at the user's discretion via a "Take a Snapshot" menu option (see, for example, column 13, lines 21-59 and FIGS. 9 and 11). Moreover, Dupperouzel is ostensibly silent regarding the <u>timing</u> of when such user

settings for a web page should be saved via the "Take a Snapshot" menu option. As such, Dupperouzel clearly fails to teach or suggest the <u>desirability</u> of saving user settings for a web page <u>in response to a signal for exiting the web page</u>, as required by independent claims 1, 5, 11 and 16, and thereby teaches a <u>completely different solution</u> for saving user settings for a web page than the claimed invention.

Appellants further submit that there are significant advantages associated with saving user settings for a web page <u>in response to a signal for exiting the web page</u> (as claimed), as opposed to saving user settings for a web page via the "Take a Snapshot" menu option (as taught by Dupperouzel). First, by saving user settings for a web page <u>in response to a signal for exiting the web page</u> (as claimed), there is an <u>inherent</u> potential to reduce processor overhead by reducing the number of save operations it must perform. That is, since the user settings for a web page are saved <u>in response to a signal for exiting the web page</u>, there is no need for users to even attempt to save such settings (and thus require processor overhead for a save operation) while they are navigating the web page. This, in turn, advantageously allows users to focus on navigating the web page without having to remember to save their preferred settings for the web page before exiting the same. In this manner, the claimed solution for saving user settings for a web page <u>in response to a signal for exiting the web page</u> effectively eliminates the need for the solution taught by Dupperouzel, wherein users must inconveniently interrupt their web page navigation, access the "Take a Snapshot" menu option, save their settings, and then resume their navigation of the web page. Accordingly, Appellants submit that their claimed solution for saving user settings for a web page has significant advantages over the solution taught by Dupperouzel.

Finally, on pages 4 and 11 of the final Office Action dated November 13, 2008, the Examiner cites *In re Venner*, 262 F.2d 91, 120 USPQ 193 (CCPA 1958) for the proposition that "broadly providing an automatic means to replace a manual activity which accomplishes the same results is not sufficient to distinguish over the prior art."

In response, Appellants submit that the claimed invention is not simply directed towards automating a manual activity, as alleged. Rather, the claimed invention also inherently involves a _timing_ issue, namely the issue of _when_ user settings for a web page should be saved. In particular, the claimed invention recognizes the desirability of saving such user settings _at the time of exiting the web page_ (i.e., in response to a signal for exiting the web page). In contrast to the claimed invention, and as indicated above, Dupperouzel is ostensibly silent regarding the _timing_ of when such user settings for a web page should be saved via the "Take a Snapshot" menu option. As such, Dupperouzel fails to teach or suggest the _desirability_ of the claimed invention, and instead, teaches a _completely different solution_ for saving user settings for a web page than the claimed invention.

Accordingly, for at least the foregoing reasons, Appellants submit that claims 1-21 are patentable under 35 U.S.C. §103(a) over Duperrouzel, and respectfully request that the Board reverse the rejection of claims 1-21, and pass this application to issue.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,

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VIII. Claims Appendix

1.   A method of communicating electronic information using a browser, the method comprising the steps of:

a.   invoking the browser in a display device;

b.   accessing a web page in response to a viewer specifying a URL in the browser;

c.   retrieving a viewer adjustable setting for the URL from a memory;

d.   applying the retrieved viewer adjustable setting to the web page;

e.   automatically saving a current state of the viewer adjustable setting in the memory in response to a signal for exiting the web page; and

f.   automatically applying the current state of the viewer adjustable setting to the web page a next time the web page is accessed.

2.   The method of claim 1 wherein the viewer adjustable setting includes at least one of a text setting and a graphics setting.

3.   The method of claim 1 wherein the web page is displayed on a display other than a computer monitor selected from a television screen, a cell phone, and a personal data assistant.

4.   The method of claim 1 wherein the URL is specified in the browser by entering the URL in an address box field in the web browser, by clicking on a hyperlink, or by selecting a favorite or bookmark from a stored list.

5.   A method of displaying a web page with a user-preferred format setting for the web page, the method comprising the steps of:

a.   receiving a user input representing the user-preferred format setting for the web page while the web page is displayed;

b.   automatically storing the user-preferred format setting in association with a URL for the web page in response to a signal for exiting the web page; and

c.   automatically applying the user-preferred format setting to the web page a next time the web page is accessed.

6.   The method of claim 5 wherein the user-preferred format setting includes at least one of text and graphics sizing.

7.   The method of claim 6 wherein the web page is displayed on a display other than a computer monitor selected from a television screen, a cell phone, and a personal data assistant.

8.   The method of claim 5 wherein the web page is accessed the next time by a user clicking on a hyperlink in a different web page, by a user entering the URL for the web page in an address box on a web browser, or by a user selecting a favorite or bookmark from a stored list.

9.   The method of claim 5 wherein the user-preferred format setting is stored in association with the URL for the web page in at least one of a history registry and a favorites registry.

10.   The method of claim 5 wherein previously selected formats are stored in association with corresponding URLs in a history registry and/or with corresponding URLs in a favorites registry.

11.   A system for processing requests for web pages comprising:

a.   means for fetching a web page upon receipt of a URL request;

b.   means for receiving a user adjustable format preference for the web page;

c.   means for automatically storing a current user adjustable format preference for the web page in response to a signal for exiting the web page; and

d.   means for automatically applying the current user adjustable format preference to the web page a next time the web page is fetched.

12.   The system of claim 11 wherein the user adjustable format preference includes at least one of a text preference and a graphics preference.

13.   The system of claim 11 comprising a microprocessor, application program, storage, and I/O components.

14.   The system of claim 13 further comprising a display selected from a television screen, a cell phone display, and a personal data assistant display.

15.   The system of claim 11 having means to deliver a web browser to a display, means to receive user selections, and means to format web pages according to stored user preferences associated with a corresponding URL.

16.   A computer program embodied on a computer readable medium for displaying a web page with user-preferred formatting for that web page, the computer program comprising:

a.   a code segment for receiving user adjustable format selections for a displayed web page, and for automatically storing a current user adjustable format selection in association with a URL for the displayed web page in response to a signal for exiting the displayed web page;

b.   a code segment for receiving a next request for the URL, and for automatically retrieving the current user adjustable format selection in response to the next request; and

c.   a code segment for automatically displaying the web page with the current user adjustable format selection in response to the next request.

17.   The computer program of claim 16, wherein the code segment for receiving the user adjustable format selections stores the current user adjustable format selection in a primary memory.

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18.   The computer program of claim 16, wherein the code segment for receiving the user adjustable format selections stores the current user adjustable format selection in a secondary memory.

19.   The computer program of claim 16, wherein the code segment for receiving the user adjustable format selections stores the current user adjustable format selection in association with the URL in a history registry and/or in a favorites registry.

20.   The computer program of claim 16, wherein the code segment for receiving the next request for the URL receives the next request from a user clicking on a hyperlink in a different web page, entering the URL in an address box on a web browser, or selecting a favorite or bookmark from a stored list.

21.   The computer program of claim 16, wherein one of the user adjustable format selections is text size.

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IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.